

Application No.: 10/849,774
Attorney Docket No.: 54525.000108

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Remarks

Reconsideration of this Application is respectfully requested. In response to the Office Action ("Action") mailed April 19, 2006, Applicants have amended claims 1 and 10. Claims 1-14 are pending.

Based on the above Amendment and the following Remarks, Applicants respectfully request that the Examiner reconsider and withdraw all outstanding rejections.

Rejections under 35 U.S.C. § 103

On page 2, the Action rejects claims 1-14 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 4,677,362 to House, II et al. (hereinafter "House") in view of U.S. Patent No. 4,553,306 to Mineck (hereinafter "Mineck").

A. Response to the Rejection of Claim 1

Amended claim 1 recites:

A reciprocating saw comprising
a rotary motor;
a housing enclosing the rotary motor, the housing having a handle portion with a trigger switch for controlling the rotary motor;
a reciprocating shaft extending out from the housing and having a device for mounting a saw blade thereto; and
a clip directly and only attached to the housing which suspends the reciprocating saw from an accommodating means when the reciprocating saw is not in use. (Emphasis added.)

For at least the following reasons, the combined teachings of House and Mineck do not disclose amended claim 1.

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First, neither House nor Mineck disclose or suggest a reciprocating saw including a housing enclosing a rotary motor and a clip directly and only attached to the housing. Specifically, neither House nor Mineck disclose or suggest a reciprocating saw comprising "a rotary motor; a housing enclosing the rotary motor, . . . and a clip directly and only attached to the housing" (emphasis added), as recited in amended claim 1. To reject claim 1, page 2 of the Action cites figure 10 and a clip 20 disclosed by House. Applicants respectfully disagree that these cited features of House disclose the above identified features of amended claim 1.

FIG. 10 of House depicts a "front view of the base of the recharging unit." See House, col. 2, ll. 55-56, col. 4, ll. 9-26. Clearly, a recharging unit is not a reciprocating saw including a housing and a clip directly and only attached to the housing.

The clip 20 of House also does not teach the above identified features of amended claim 1. Instead of disclosing that the clip 20 is directly and only attached to the housing of the electric drill, House discloses that the clip 20 is attached to a holster 12. Specifically, House discloses a "holster-like device" for storing a tool. See House, col. 3, ll. 6-11. House discloses a holster 12 that "includes a tool storing portion 14 that has an internal surface which complements the outer surface of the electric drill such that it is retained in the tool storing portion 14." See House, col. 3, ll. 14-18. House states that "the holster 12 includes a U-shaped clip 20 having a downward facing opening that can be placed over the belt of the user of the tool." See House, col. 3, ll. 30-34. Hence, House teaches that the clip 20 is attached to the holster 12, and is not directly and only attached to the electric drill 10. (See also FIG. 5 depicting the holster 12 without the electric

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drill.) Thus, House does not teach an electric drill that includes a housing enclosing a rotary motor and a clip directly and only attached to the housing. Applicants note that the Action relies on Mineck for a disclosure of reciprocating saws, and does not rely on Mineck for a teaching of a clip attached to the housing of a reciprocating saw. Therefore, claim 1 is believed to be allowable over House in view of Mineck, and allowance thereof is respectfully requested.

Second, the Action has not provided proper motivation for combining House with Mineck to establish a *prima facie* case of obviousness. On page 2, the Action admits that House does not "show a reciprocating saw." The Action then relies on Mineck, which the Action alleges "teaches a reciprocating saw 11 for the purpose of cutting studs." The Action argues that it would have been obvious to modify the device of House "by providing the reciprocating saw as taught by Mineck in order to obtain [a] device that cuts studs." Applicants respectfully disagree that this is proper motivation for combining House with Mineck to establish a *prima facie* case of obviousness for rejecting claim 1.

Claim 1 recites a reciprocating saw comprising a housing enclosing a rotary motor and a clip directly and only attached to the housing. House does not depict the clip 20 being used on reciprocating saws. Mineck discloses a U-shaped clip 16 for securing an end of a saw blade 17 to a hand held reciprocating saw 11. See Mineck, col. 2, ll. 60-64. Mineck does not disclose the U-shaped clip 16 for suspending a reciprocating saw from an accommodating means.

Nevertheless, the Action argues that since reciprocating saws have the ability to cut studs, one of ordinary skill in the art would be motivated to modify the drill 10 of House to be a reciprocating

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saw as disclosed by Mineck and to place the clip 20 of House on the reciprocating saw 11 of Mineck for suspending the reciprocating saw from an accommodating means. Applicants respectfully disagree.

If one of ordinary skill in the art reviewed Mineck and became aware that reciprocating saws have an ability to cut studs, as alleged in the Action, and then reviewed House's disclosure of an electric drill 10 with a clip 20 included on a holster 12 for securing the holster 12 to a user's clothing, one of ordinary skill in the art would not be motivated to place the clip 20 from House on the reciprocating saw 11 of Mineck simply because reciprocating saws have the ability to cut studs. Applicants submit that cutting studs with a reciprocating saw is irrelevant to the modification proposed in the Action. The Action uses hindsight reconstruction based on Applicant's disclosure for motivation to combine House and Mineck. Thus, the Action has not presented proper motivation for modifying House based on Mineck. Therefore, one of ordinary skill in the art would not be motivated to combine House and Mineck based on a reciprocating saw's ability to cut studs. Accordingly, the rejection of claim 1 is improper and claim 1 is also believed to be allowable for this reason.

B. Response to the Rejections of Claims 2-9

Claims 2-9, which depend from claim 1, also are believed to be in condition for allowance due to their dependence on an allowable claim.

At least claim 2 is separately patentable over House in view of Mineck. Claim 2 recites "the clip can be mounted to the reciprocating saw at a minimum of two distinct positions on the

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reciprocating saw" (emphasis added). To reject claim 2, page 2 of the Action cites FIGs. 1-4 of House. Thus, the Action argues that FIGs. 1-4 of House disclose "a clip [that] can be mounted in two distinct position[s]." Applicants respectfully disagree.

FIGs. 1-4 of House disclose multiple views of the same embodiment of a drill, instead of a clip that can be mounted in two distinct positions. This point becomes clear upon reviewing the "Brief Description of the Drawings" of House, which states that:

FIG. 1 is a top plan view of an embodiment of the invention where the rechargeable tool is a drill resting within a holster and a recharging base.
FIG. 2 is a partial cross-sectional view of the drill within the holster showing the belt clip and the opening giving access to the electrical contacts on the housing of the drill.
FIG. 3 is an end view of the embodiment of FIG. 2.
FIG. 4 is a left side view of a drill within the holster.
(See House, col. 2, ll. 37-45; emphasis added.)

Thus, FIGs. 1-4 of House are different views of the same embodiment that all depict the clip 20 on one side of the drill 10, and do not disclose that the clip 20 can be mounted on two distinct positions on the drill 10.

To further illustrate this point, House discloses various features that would prevent a user from placing the drill 10 in the holster 12 to place the clip 20 on two distinct positions relative to the drill 10. First, House discloses that "the holster 12 includes a tool storing portion 14 that has an internal surface which complements the outer surface of the electric drill such that it is retained in the tool storing portion 14." Second, House discloses that:

the electric drill 10 includes two electrical contacts 24 on the side of the drill. These contacts are electrically connected to batteries within the rechargeable tool and facilitate the recharging of those batteries. As shown in FIG. 4, the side of the holster 12 includes an opening 26 that exposes the contacts 24 on the drill 10.
(See House, col. 3, ll. 46-54; emphasis added.)

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Thus, the drill 10 of House must be placed in the holster 12 so that the electrical contacts 24 are positioned within the opening 26 (see also FIG. 5). In other words, the drill 10 would always be placed in the holster 12 in the same way with the clip 20 being on the same side to permit the electrical contacts 24 to be positioned within the opening 26 and to permit the complementary surfaces of the holster 12 to retain the drill 10. Hence, the clip 20 of the holster 12 is always positioned on the same side when the drill 10 is inserted into the holster 12, and not in "two distinct positions" as alleged in the Action. The Action does not indicate that Mineck discloses this claim feature. Since the Action has not established that either House or Mineck disclose a "clip [that] can be mounted to the reciprocating saw at a minimum of two distinct positions on the reciprocating saw" (emphasis added), as recited in claim 2, the Action has not established a *prima facie* case of obviousness to reject claim 2. Therefore, claim 2 is also believed to be allowable over House in view of Mineck and allowance thereof is respectfully requested.

B. Response to the Rejections of Claims 2-9

Claim 10 is allowable over House in view of Mineck for reasons analogous to those given in support of amended claim 1.

Claims 11-14, which depend from claim 10, also are believed to be in condition for allowance due to their dependence on an allowable claim.

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Conclusion

Applicants believe that all of the rejections in the Office Action have been addressed by the amendments and remarks above. If there are any questions concerning this Response, Applicants would welcome a telephone call or interview with the undersigned Applicants' representative.

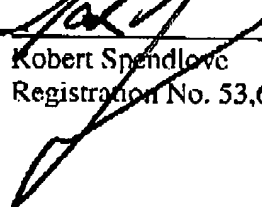
No fees are believed to be required. If the Office, however, believes that any additional required fees are due, the Commissioner is authorized to debit those fees from the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

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